



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/648,588 08/25/00 LESIMPLE

M 10767-002001

JOHN J GAGEL
FISH & RICHARDSON
225 FRANKLIN STREET
BOSTON MA 02110-2804

IM22/1107

EXAMINER

COOLEY, C

ART UNIT

PAPER NUMBER

1723

DATE MAILED:

11/07/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

OFFICE ACTION

1. This application has been assigned to Technology Center 1700, Art Unit 1723 and the following will apply for this application:

Please direct all written correspondence with the correct application serial number for this application to Art Unit 1723. Telephone inquiries regarding this application should be directed to the Technology Center 1700 receptionist at ((703) 308-0651 or to the Examiner at ((703) 308-0112. Official facsimile correspondence filed before a final office action should be transmitted to ((703) 872-9310. Official facsimile correspondence which responds to a final office action should be transmitted to ((703) 872-9311. Inquiries regarding application status, matching responses with applications, patent term questions, locating and retrieval of applications, incomplete office actions, requests for copies of office actions and/or references, requests to remail office actions, small/large entity status, or other administrative inquiries should be directed to the **Technology Center 1700 Customer Service Center** at ((703) 306-5665.

Priority

2. Acknowledgment is made of applicant's claim for priority under 35 U.S.C. § 119. The certified copy has been filed in parent application, Serial No. 098/748,891, filed on 08 OCT 1996.

Information Disclosure Statement

3. Note the attached PTO-1449 forms submitted with the Information Disclosure Statements filed 25 AUG 2000.

Reissue Oath/Declaration

4. The reissue oath/declaration filed with this application is defective because

(a) it fails to contain a statement that all errors which are being corrected in the reissue application up to the time of filing of the oath/declaration arose without any deceptive intention on the part of the applicant. See 37 CFR 1.175 and MPEP § 1414. The statement in the reissue oath/declaration filed with this application lacks the "up to the time of filing" language. See MPEP 1414 for a suggested format; and

(b) Non-initialed and/or non-dated alterations have been made to the oath or declaration. See 37 CFR 1.52(c).

Claims 1-50 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) which addresses the above deficiencies will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

Art Unit: 1723

Assignee

5. The written consent of all assignees owning an undivided interest in the patent filed 25 AUG 2000 is acceptable.

Surrender of Patent

6. The offer to surrender the original patent is acknowledged. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

Drawings

7. Requirements for drawings in reissue applications are found in 37 CFR 1.174 and MPEP 1413.
8. The request to transfer original drawings from the patent is denied. Patent drawings can no longer be transferred from the patented application (MPEP 1413). Formal drawings will be required when the instant application is allowed.
9. The drawings are objected to under 37 CFR § 1.83(a) since the drawings must show every feature of the invention specified in the claims. Therefore, the following features must be shown or the features canceled from the claims. No new matter should be entered.
 1. the subject matter of claim 16.
 2. the subject matter of claim 33.

Art Unit: 1723

3. the subject matter of claim 44.

If the above subject matter is to be shown, Applicant is required to submit a proposed drawing correction in response to this Office Action. Any proposal by the applicant for amendment of the drawings to cure defects must include a print or pen-and-ink sketch showing changes in *red ink* in accordance with MPEP § 608.02(v). No new matter is permitted.

IMPORTANT NOTE: The filing of new formal drawings to correct the noted defect may be deferred until the application is allowed by the examiner, but the print or pen-and-ink sketch with proposed corrections shown in red ink is required in response to this Office Action, and *may not be deferred*.

Recapture

10. **Claims 38, 39, 40, 42/40/39/38, 44/42/40/39/38, 45/42/40/39/38, 42/39/38, 44/42/39/38, 45/42/39/38, and 47 are rejected under 35 U.S.C. 251 as being an improper recapture of claimed subject matter deliberately canceled in the application for the patent upon which the present reissue is based.**

The recapture rule prevents a patentee from regaining through reissue the subject matter he surrendered to obtain allowance of the original patent claims. *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 221 USPQ 289, 295 (Fed. Cir. 1989); *In re Willingham*, 282 F.2d 353, 127 USPQ 211 (CCPA 1960); *In re Richman*, 161 USPQ 359, 363, 364 (CCPA

Art Unit: 1723

1969); *In re Wadlinger*, 181 USPQ 826 (CCPA 1974). The Federal Circuit stated the following principles in *Clement*:

(1) if the reissue claim is as broad as or broader than the canceled or amended claim in all aspects, the recapture rule bars the claim;

(2) if it is narrower in all aspects, the recapture rule does not apply, but other rejections are possible;

(3) if the reissue claim is broader in some aspects, but narrower in others, then: (a) if the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim; (b) if the reissue claim is narrower in an aspect germane to prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim, but other rejections are possible.

F.3d at 1469-70, 45 USPQ2d at 1165.

Furthermore, the recapture rule bars the patentee from acquiring through reissue claims that are, in all respects, of the same scope as, or are broader in scope than, those claims canceled from the original application to obtain a patent. *Ball*, 729 F.2d at 1436, 221 USPQ at 295.

With respect to claim 38, the claim merely recites a “body” and an “interference arm” which is considered broader in all respects than the scope of originally filed claim 15 in the patented application (08/748,891). The term “body” is considered a broader term than “swan-neck shaped body” appearing in originally filed claim 15 and the term “interference arm” is considered a broader term than “means for preventing rotation of the stirrer can” since 35 USC 112, sixth paragraph is invoked. Originally filed claim 15 was amended, hence the subject matter of originally filed claim 15 was surrendered, to obtain a patent. Accordingly, the recapture rule is triggered to prevent the patentee from acquiring through reissue claims that are, in all respects, of the same scope as, or are broader in scope than, those claims canceled from the original application to obtain a patent. *Ball*, supra.

With respect to claim 39, the claim merely recites an “engaging member” which is considered broader in all respects than the scope of originally filed claim 15 in the patented application (08/748,891). The term “engaging member” is considered a broader term than the term “grip” appearing in originally filed claim 15. Originally filed claim 15 was amended, hence the subject matter of originally filed claim 15 was surrendered, to obtain a patent. Accordingly, the recapture rule is triggered to prevent the patentee from acquiring through reissue claims that are, in all respects, of the same scope as, or are broader in scope than, those claims canceled from the original application to obtain a patent.

With respect to claim 40, the claim merely recites a “collar” which is considered broader in all respects than the scope of originally filed claim 15 in the patented application (08/748,891). The term “collar” is considered broader or at least the same scope as the term “grip” appearing in originally filed claim 15. Originally filed claim 15 was amended, hence the subject matter of originally filed claim 15 was surrendered, to obtain a patent. Accordingly, the recapture rule is triggered to prevent the patentee from acquiring through reissue claims that are, in all respects, of the same scope as, or are broader in scope than, those claims canceled from the original application to obtain a patent.

With respect to claim 42/40/39/38, the claim merely recites “the engaging portion [sic] is connected to a neck” which is considered broader in all respects than the scope of originally filed claim 15 in the patented application (08/748,891). The term “neck” is considered broader than the term “swan-neck shaped body” appearing in originally filed claim 15. Originally filed claim 15 was amended, hence the subject matter of originally filed claim 15 was surrendered, to obtain a patent. Accordingly, the recapture rule is triggered to prevent the patentee from acquiring through reissue claims that are, in all respects, of the same scope as, or are broader in scope than, those claims canceled from the original application to obtain a patent.

With respect to claim 44/42/40/39/38, the claim merely recites an "arm" which is considered broader in all respects than the scope of originally filed claim 15 in the patented application (08/748,891). The term "arm" is considered a broader term than "means for preventing rotation of the stirrer can" since 35 USC 112, sixth paragraph is invoked. Originally filed claim 15 was amended, hence the subject matter of originally filed claim 15 was surrendered, to obtain a patent. Accordingly, the recapture rule is triggered to prevent the patentee from acquiring through reissue claims that are, in all respects, of the same scope as, or are broader in scope than, those claims canceled from the original application to obtain a patent.

With respect to claim 45/42/40/39/38, the claim merely recites a pivotable arm which is considered broader in all respects than the scope of originally filed claim 20 in the patented application (08/748,891). Originally filed claim 20 was amended, hence the subject matter of originally filed claim 20 was surrendered, to obtain a patent. Accordingly, the recapture rule is triggered to prevent the patentee from acquiring through reissue claims that are, in all respects, of the same scope as, or are broader in scope than, those claims canceled from the original application to obtain a patent.

With respect to claim 42/39/38, the claim merely recites “the engaging portion [sic] is connected to a neck” which is considered broader in all respects than the scope of originally filed claim 15 in the patented application (08/748,891). The term “neck” is considered broader than the term “swan-neck shaped body” appearing in originally filed claim 15. Originally filed claim 15 was amended, hence the subject matter of originally filed claim 15 was surrendered, to obtain a patent. Accordingly, the recapture rule is triggered to prevent the patentee from acquiring through reissue claims that are, in all respects, of the same scope as, or are broader in scope than, those claims canceled from the original application to obtain a patent.

With respect to claim 44/42/39/38, the claim merely recites an “arm” which is considered broader in all respects than the scope of originally filed claim 15 in the patented application (08/748,891). The term “arm” is considered a broader term than “means for preventing rotation of the stirrer can” since 35 USC 112, sixth paragraph is invoked. Originally filed claim 15 was amended, hence the subject matter of originally filed claim 15 was surrendered, to obtain a patent. Accordingly, the recapture rule is triggered to prevent the patentee from acquiring through reissue claims that are, in all respects, of the same scope as, or are broader in scope than, those claims canceled from the original application to obtain a patent.

Art Unit: 1723

With respect to claim 45/42/39/38, the claim merely recites a pivotable arm which is considered broader in all respects than the scope of originally filed claim 20 in the patented application (08/748,891). Originally filed claim 20 was amended, hence the subject matter of originally filed claim 20 was surrendered, to obtain a patent.

Accordingly, the recapture rule is triggered to prevent the patentee from acquiring through reissue claims that are, in all respects, of the same scope as, or are broader in scope than, those claims canceled from the original application to obtain a patent.

With respect to claim 47, the scope of the claim is narrower in claiming a “molded body” but this limitation does not modify the claim such that the scope of the claim no longer results in recapture of the surrendered subject matter since this product-by-process limitation does not impart patentability to the claim (MPEP 2113) and the claim merely recites a “molded body”, an “interference arm”, and an “engaging member” which is considered broader in all respects than the scope of originally filed claim 15 in the patented application (08/748,891). The term “body” is considered a broader term than “swan-neck shaped body” appearing in originally filed claim 15, the term “interference arm” is considered a broader term than “means for preventing rotation of the stirrer can” since 35 USC 112, sixth paragraph is invoked, and the term “engaging member” is considered a broader term than the term “grip” appearing in originally filed claim 15. Originally filed claim 15 was amended, hence the subject matter of originally filed claim 15 was surrendered, to obtain a patent. Accordingly, the recapture rule is triggered to prevent the patentee from acquiring through reissue claims that are, in all respects, of the same scope as, or are broader in scope than, those claims canceled from the original application to obtain a patent. *Ball*, supra.

Claim Rejections - 35 U.S.C. § 112, second paragraph

11. Claims 15-50 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 1723

The second paragraph of 35 USC 112 requires a claim to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Under *In re Hammack*, 166 USPQ 204 (CCPA 1970) and *In re Moore*, 169 USPQ 236 (CCPA 1971), claims must be analyzed to determine their metes and bounds so that it is clear from the claim language what subject matter the claims encompass. This analysis must be performed in light of the applicable prior art and the disclosure. The definiteness of the claims is important to allow others who wish to enter the market place to ascertain the boundaries of protection that are provided by the claims. *Ex parte Kristensen*, 10 USPQ 2d 1701, 1703 (BPAI 1989). The pending claims fail to particularly point out and distinctly claim the subject matter which applicant regards as the invention and are therefore indefinite for the following reasons:

In the claims, the term “downwardly” and “pivotable” is referenced with respect to what reference axis, surface, plane, or element? For example, is the interference arm pivotable with respect to the stirring head body or some other arrangement?

Claim 15 is vague and incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The structural cooperative relationship between the interference arm and the other recited elements is unclear since the arm is not structurally connected to anything.

The scope of claim 15 is also unclear in that it is not known if the "can" is a positively recited element of the claim.

Claim 18: the interference arm is pivotable with respect to what reference axis, surface, or plane?

Claim 24: "the engaging portion" lacks antecedent basis - change to --the engaging member--; in line 2, "a downwardly extending neck" of what element is being referred to?

Claim 25, line 1: insert a space between "24" and "wherein"; "the interference member" lacks antecedent basis - change to --the interference arm--; "the engaging portion" lacks antecedent basis - change to --the engaging member--.

Claim 27: "the engaging portion" lacks antecedent basis - change to --the engaging member--.

The scope of claim 29 is unclear in that it is not known if the "can" is a positively recited element of the claim.

Claim 32, line 3: "the engaging portion" lacks antecedent basis - change to --the engaging member--.

Claim 38, line 4: "the stirrer" lacks antecedent basis.

Claim 42, line 3: "the engaging portion" lacks antecedent basis - change to --the engaging member--; in line 2, "a neck" of what element is being referred to?

Claim 43, line 2: "the neck element" lacks antecedent basis.

Claim 48, line 1: replace "on" with --an--.

Claim 49, line 1: it is unclear what constitutes "a neck position"; in line 2, "the engaging portion" lacks antecedent basis - change to --the engaging member--.

Claim 50: "the engaging portion" lacks antecedent basis - change to --the engaging member--.

12. Each pending claim should be thoroughly reviewed such that these and any other informalities are corrected so the claims may particularly point out and distinctly claim the subject matter which applicant regards as the invention, as required by 35 U.S.C. § 112, second paragraph. The claims are being treated on the merits to the extent they are considered definite.

Claim Rejections - 35 U.S.C. § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 15, 16, 17, 19/15, 19/16/15/, 19/17/15, 20/19/16/15, 20/19/17/15, 20/10, 21, 22, 23, 28/19/16/15, 28/19/17/15, 28/19/15, 29, 30, 33/30/29, 34/30/29, 36/30/29, 37/30/29, 38, 39, 41, 47, and 48 are rejected under 35 U.S.C. § 102(b) as being anticipated by Neri.

The patent to Neri discloses a paint stirring system comprising a can 8 for paint; can cover 10; drive shaft 13 connected to a paint stirrer in the can; shelf 9 for supporting the can; stirring head body 1 positioned above the shelf; downwardly extending interference arms 2', 2" that prevent rotation of the can; the can cover including a pouring spout and the interference arms engage the spout as seen in Fig. 4; the shelf 9 being free of pins; engaging member or collar 3 or 4; the stirring head body including openings 5 for receiving a drive spindle (Figs. 2 and 3).

Furthermore, the product-by-process limitation (i.e., the manner in which the stirring head body is manufactured, i.e., by molding) does not impart patentability to the claims per MPEP 2113.

The scope of claim 39 is merely drawn to an engaging member (note the element deemed equivalent to the recited engaging member is element 3 or 4 in Neri) since 35 USC 112, sixth paragraph is not invoked pursuant to MPEP 2181).

With respect to the term "resilient", the engaging member or collar 3 or 4 can be deemed resilient as resilient is a relative term and the claims set forth no parameters on the dividing line between what constitutes a resilient member as opposed to a non-resilient member.

Claim Rejections - 35 U.S.C. § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claim 31 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Neri.

Neri does not disclose the body being formed from plastic. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have formed any of the components of the paint stirring equipment from plastic,

Art Unit: 1723

including the body, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416; *Sinclair & Carroll Co., Inc. v. Interchemical Corp.*, 65 USPQ 297 (1945).

Furthermore, in view of the fact that the use of plastic vis-à-vis any other common construction material solves no stated problem insofar as the record is concerned and the conclusion of obviousness can be made from the common knowledge and common sense of one of ordinary skill in the art (*In re Bozek*, 416 F.2d 1385, 163 USPQ 545 (CCPA 1969)), it would have been obvious to one of ordinary skill in the art to have formed any of the components of the prior art paint stirring equipment of Neri from a well-known construction material such as plastic. *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975).

It is observed that artisans must be presumed to know something about the art apart from what the references disclose (see *In re Jacoby*, 309 F.2d 513, 135 USPQ 317 (CCPA 1962)). Moreover, skill is presumed on the part of those practicing in the art. See *In re Sovish*, 769 F.2d 738, 226 USPQ 771 (Fed. Cir. 1985). Therefore, it is concluded that the selection of a well-known material in the art such as plastic would have been obvious to one of ordinary skill in this art, if for no other reason than to achieve the advantage of using a more modern material or a lower cost or more easily fabricated material.

* * *

17. While the examiner might speculate as to what is meant by the language of claims 18/15, 19/18/15, 20/19/18/15, 28/19/18/15, 24-27, 35/32/31/30/29, 35/30/29, 42-46, and 49-50, the uncertainty provides the examiner with no proper basis for making the comparison between that which is claimed and the prior art (MPEP 2173.06).

Rejections under 35 U.S.C. 103 should not be based upon "considerable speculation as to the meaning of terms employed and assumptions as to the scope of the claims." *In re Steele*, 305 F.2d 859, 134 USPQ 292 (CCPA 1962). When no reasonably definite meaning can be ascribed to certain terms in a claim, the subject matter does not become obvious, but rather the claim becomes indefinite. *In re Wilson*, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970). As it has been held that it is improper to rely on what are at best speculative assumptions as to the meaning of a claim and then base a rejection under 35 U.S.C. 103 thereon, no such rejections have been made concerning claims 18/15, 19/18/15, 20/19/18/15, 28/19/18/15, 24-27, 35/32/31/30/29, 35/30/29, 42-46, and 49-50. *Ex parte Brummer*, 12 USPQ2d 1654. However, the lack of such rejections should not be construed as meaning that the claims as presently drawn would be patentable if corrected. Any response should carefully consider the prior art of record in accordance with 37 CFR 1.111.

Allowable Subject Matter

18. Claims 1-14 would be allowable if rewritten or amended to overcome the rejection under 35 U.S.C. § 251.

Art Unit: 1723

19. Claims, 32/31/30/29, 33/32/31/30/29, 34/32/31/30/29, 36/32/31/30/29, and 37/32/31/30/29 would be allowable if rewritten to overcome the rejection under 35 U.S.C. §§ 112, 251 and to include all of the limitations of the base claim and any intervening claims.

Conclusion

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Charles Cooley whose telephone number is (703) 308-0112.

22. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1700 receptionist whose telephone number is (703) 308-0651.



Dated: 19 October 2001

**Charles Cooley
Primary Examiner
Art Unit 1723**